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In re Application of:  
HENDRIX, Martin, et al. : DECISION REGARDING  
U.S. Application No.: 10/519,134 : SUBMISSION UNDER  
PCT No.: PCT/EP03/06662 : 37 CFR 1.42  
International Filing Date: 25 June 2003 :  
Priority Date: 08 July 2002 :  
Attorney's Docket No.: Le A 36 080 :  
For: HETERO-CYCLICALLY :  
SUBSTITUTED :  
IMADAZOTRIAZINES :

This communication is issued in response to applicants' submission on 07 October 2005 of a declaration executed on behalf of a deceased inventor, which has been treated as a submission under 37 CFR.1.42.

**BACKGROUND**

On 25 June 2003, applicants filed international application PCT/EP03/06662 that claimed a priority date of 08 July 2002 and designated the United States. On 15 January 2004, a copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) by the International Bureau (IB). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 08 January 2005.

On 22 December 2004, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, an English translation of the international application and payment of the basic national fee.

On 05 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration acceptable under 37 CFR 1.497, the surcharge for filing the oath or declaration late, and sequence listing materials were required.

On 07 October 2005, applicants filed a response to the Notification Of Missing Requirements (with required one-month extension fee) that included payment of the required surcharge, a declaration executed by the surviving inventors and on behalf of deceased inventor Ulrich NIEWOHNER by his heiress, Maria NIEWOHNER, and a statement that the present

application does not include the disclosure of an amino acid or nucleotide sequence listing. The declaration is considered below as a submission under 37 CFR 1.42 and 1.497.

## DISCUSSION

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

Pursuant to 37 CFR 1.497(b)(2), the declaration must provide the citizenship, mailing address, and residence information for **both** the deceased inventor and the legal representative or heir. Here, the filed declaration contains the information required under 37 CFR 1.497(b)(2), including the citizenship, address, and residence information for both the deceased inventor and his heiress. Applicants have also provided a statement, with supporting documentation, confirming that the listed heiress is the sole heir of the deceased inventor.

The submission of the declaration executed by heiress of the deceased inventor is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed. If this interpretation is incorrect, applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

Based on the above, if otherwise acceptable under 37 CFR 1.497, the declaration filed 07 October 2005 would be acceptable under 37 CFR 1.42 with respect to deceased inventor Ulrich NIEWOHNER. However, a review of the declaration filed 07 October 2005 reveals a defect with respect to the name of one of the surviving inventors. Specifically, the name of the ninth inventor is identified as Dagmar SCHAUSS on the international application (and on the Application Data Sheet filed 22 December 2004); this inventor is identified as Dagmar

KARTHAUS on the declaration filed 07 October 2005. The declaration is therefore defective for failure to properly identify all of the inventors of record herein.

Section 605.04(b) of the Manual Of Patent Examining Procedure ("MPEP") states that:

Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

In this case, the difference between the ninth inventor's name in the published international application (SCHAUSS) and the declaration (KARTHAUS) appears to be more than a mere typographical error or a phonetic misspelling of the applicant's name. Accordingly, a petition under 37 CFR 1.182 to correct the name of the ninth inventor is required before the present declaration can be accepted under 37 CFR 1.497 and 1.42. For such a petition to be grantable, MPEP § 605.04(c) states that "the petition must include an appropriate petition fee and an affidavit signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a certified copy of the court order."

### CONCLUSION

The 07 October 2005 submission under 37 CFR 1.42 and 1.497 is **REJECTED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date this communication to submit a proper response under 37 CFR 1.42 and 1.497. Failure to file a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include a petition correcting the name of record for the ninth inventor to the name set forth on the declaration, as discussed above.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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